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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
WANG, SHENGJUN	
ART UNIT	**PAPER NUMBER**
1617	

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/926,554	SALLE ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *50-82* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *50-82* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt of applicants' amendments and remarks submitted September 29, 2005 is acknowledged.

Double Patenting Rejections

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 50-82 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-53 of copending Application No. 10/363,935. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application is drawn to a pharmaceutical compositions and methods for chemopreventing or controlling the growth of estrogen dependent cancers comprising exemestane in combination with the instant antineoplastic agents such as, a taxane compound, docetaxel, or an anthracycline compound, epirubicin.

3. The claims of the instant application are drawn to the employment of exemestane in combination with the instant antineoplastic agent, epirubicin or docetaxel in pharmaceutical

compositions and methods for treating breast cancer in humans and lowering the side effects in humans.

Thus, the instant claims are seen to be obvious over the claims 6-53 of copending Application No. 10/363,935.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections 35 U.S.C. 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 50-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buzzetti et al. (US 4808616, of record) in view of Tognella et al. (4,871,528, of record) and Shashoua et al. (5,795,909 of record).

Buzzetti et al. discloses that 6-methyleneandrosta-l, 4-diene-3, l7-dione (see col.2, line 29-30), having structural formula (1) therein (col. 1, line 50-59), also known as exemestane or FCE 24304, is known to be useful in the treatment of hormone-dependent cancers such as breast, endometrial, ovarian cancers in mammals (see abstract, col. 1, lines 5-14). Buzzetti et al. also discloses that the effective amount of exemestane or FCE 24304 is about 10 to about 150-200 mg/day, which is within the claimed range herein.

Buzzetti et al. does not expressly disclose the employment of exemestane in combination with the instant antineoplastic agent, epirubicin or docetaxel in pharmaceutical compositions and methods for treating breast cancer in humans and lowering the side effects in humans.

Tognella et al. discloses mono- or polychemotherapy against tumors including breast cancer, thus avoiding dangerous side-effects and increasing the long-term survival rates (see abstract). Tognella et al. discloses that the known anti-tumor agents, epirubicin (the anthracycline compound, see col.3 lines 50-57) and other known antineoplastic agents (e.g., cyclophosphamide, methotrexate, etoposide, and 5-fluorouracil), in combination, or in combination with reduced glutaihione (GSH), is useful in a composition and a method of treating breast cancer in humans and lowering the side effects in humans caused by breast cancer therapy with anti-tumor agents. See abstract, col. 1 lines 20-38. Tognella et al. further discloses the effective amounts of the active agents in a composition to be administered for treating breast cancer in humans to produce synergistic effects (see col.4 lines 21-25 and 42-54, Table at col.5 lines 57-63, Table 1-4 at col.10-12) or surprising results against tumors by polychemotherapy (see abstract).

Shashoua et al. discloses that the instant preferred antineoplastic agents such as paciliotaxe, docetaxel, edatrexate, epirubicin, s-fluorouracil, gemcitabine, irinotecan, mitoxantrone and topotecan, and the instant preferred aromatase inhibitors such as anastrozole, fadrozole, letroxole, vorozole and exemestane, are known to be useful in the treatment of cancers, tumors or proliferative disorders including breast cancer (see Fig. 27) and reducing side-effects. See abstract, col. 1, lines 45-46 and col.30 line 48 to col. 32.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ exemestane in combination with the instant antineoplastic agent, epirubicin or docetaxel in pharmaceutical compositions and methods for treating breast cancer in humans and lowering the side effects in humans.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ exemestane in combination with the instant antineoplastic agent, epirubicin or docetaxel in pharmaceutical compositions and methods for treating breast cancer in humans and lowering the side effects in humans, since the instant antineoplastic agents such as epirubicin and docetaxel, and exemestane, alone and/or in combination, are known to be useful in pharmaceutical compositions and methods for treating breast cancer in humans and/or lowering the side effects in humans based on the prior art.

Therefore, one of ordinary skill in the art would have reasonably expected that combining exemestane and epirubicin or docetaxel in pharmaceutical compositions to be administered, both known useful for the same purpose, i.e., treating breast cancer, would improve the therapeutic effects for treating the same disorder, and/or would produce additive therapeutic effects in treating the same. See In re Kerkhoven, 205 USPQ 1069 (CCPA 1980) regarding combination inventions. It is considered prima facie obvious to combine two active composition components into a single composition to form a third composition useful for the very same purpose; idea of combining them flows logically from their having been individually taught in prior art.

Moreover, polychemotherapy against tumors is known to avoid dangerous side-effects and increasing the long term survival rates and producing synergistic effects or surprising results against tumors including breast cancer in humans according to Tognella et al. Thus, the teachings

of Tognella et al. in regard to the combination chemotherapies for breast cancer using the instant agents have also provided the motivation to make the present invention.

Additionally, one of ordinary skill in the art would have been motivated to optimize the effective amounts of active agents in the composition because the optimization of known effective amounts of known active agents to be administered based on the prior ad, is considered well within the skill of artisan. It has been held that. It is within the skill in the art to select optimal parameters, such as amounts of ingredients, in a composition in order to achieve a beneficial effect. See In re Boesch, 205 USPQ 215 (CCPA 1980).

Thus the claimed invention as a whole is clearly prima facie obvious over the combined teachings of the prior art.

Response to the Arguments

Applicants' amendments and remarks submitted September 29, 2005 have been fully considered, but are not persuasive.

1. Applicants contend that the rejections set forth above are based on an "obvious to try" stand, which is impermissible. The examiner disagrees. Applicants may not simply assert "obvious to try" without pointing out what parameters would have need to be tried before reach the claimed invention. As stated in In re O'Farrell, 7 U.S.P.Q. 2d 1673 (CAFC 1988) "Rejection of patent application *cannot be* overturned on ground that examiner and Board of Patent Appeals and Interferences applied impermissible "obvious to try" standard, since assignment of error for application of such standard usually occurs when invention is made by varying all parameters or trying each of numerous choices *until successful without indication in prior art as to which parameters were critical or which choices were likely to be successful,* or when invention is

made by exploring promising new technology or general approach with only general guidance from prior art as to particular form of claimed invention or how to achieve it, and since neither situation is present in instant case." (Emphasis added). In the instant situation, as in O'Farrell, there is no such critical parameter that is not obvious at the time the claimed invention was made. Applicants have failed to point out (and the examiner could not find) any successful story residing in the claimed invention, nor have applicants specified the critical parameter(s) that make the claimed invention patentable distinct from the prior art. The date presented in the application has been carefully reviewed. The examiner fails to seen any unexpected benefit residing in the claimed invention. Particularly, applicants just did what have been suggested by the prior arts, combining two different anti-cancer agents and expecting some additive or synergistic effects.

Regarding the establishment of unexpected results, a few notable principles are well settled. It is applicant's burden to explain any proffered data and establish how any results therein should be taken to be unexpected and significant. See MPEP 716.02 (b). The claims must be commensurate in the scope with any evidence of unexpected results. See MPEP 716.02 (d). Further, A DECLARATION UNDER 37 CFR 1.132 must compare the claimed subject matter with the closest prior art in order to be effective to rebut a prima facie case if obviousness. See, MPEP 716.02 (e).

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SHENGJUN WANG
PRIMARY EXAMINER

Shengjun Wang
Primary Examiner
Art Unit 1617